

DETAILED ACTION

In response to the preliminary amendment filed on October 14, 2008 in which original claims 1-18 were canceled and new claims 19-47 were introduced, the following new restriction/election requirement is made.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 19-39, drawn to a method for automatically determining whether a sample liquid to be tested in an optical measuring instrument is a test sample or a control sample by measuring a special property of the control sample, classified in class 436, subclass 164.
 - II. Claim 40, drawn to a method for automatically determining whether a sample liquid to be tested in an electrochemical measuring instrument is a test sample or a control sample, wherein the control sample is provided with an electrolyte which increases the conductivity of the control sample in comparison to the conductivity of a test sample, classified in class 436, subclass 149.
 - III. Claim 41, drawn to a method for automatically determining whether a sample liquid to be tested in an electrochemical measuring instrument is a test sample or a control sample, wherein the electrochemical measurement includes measuring the time required for the sample liquid to reach its end value and the constancy of the end value, classified in class 436, subclass 149.

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- IV. Claims 42-44, drawn to a method for automatically determining whether a sample liquid to be tested in a generic measuring instrument is a test sample or a control sample, wherein a control sample has a different flow characteristic than found in a test sample, classified in class 436, subclass 8.
- V. Claims 45-47, drawn to a method for automatically determining whether a sample liquid to be tested in a generic measuring instrument is a test sample or a control sample, wherein a measurement of a wetting property of a sample liquid determines whether the sample liquid is a test sample or a control sample classified in class 436, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group I operates using an optical measuring instrument to measure a special property of a sample liquid, whereas the invention of Group II operates using an electrochemical measuring instrument to measure the conductivity of a sample liquid.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group I operates using an optical measuring instrument to measure a special property of a

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sample liquid, whereas the invention of Group III operates using an electrochemical measuring instrument to measure the time required for a sample liquid to reach an end value and the constancy of that end value.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group I operates using an optical measuring instrument to measure a special property of a sample liquid, whereas the invention of Group IV operates using a generic measuring instrument to measure a flow characteristic of a sample liquid.

5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group I operates using an optical measuring instrument to measure a special property of a sample liquid, whereas the invention of Group V operates using a generic measuring instrument to measure a wetting property of a sample liquid.

6. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention Group II operates using an electrochemical measuring instrument to measure the conductivity of

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a sample liquid, whereas the invention of Group III operates using an electrochemical measuring instrument to measure the time required for a sample liquid to reach an end value and the constancy of that end value.

7. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention Group II operates using an electrochemical measuring instrument to measure the conductivity of a sample liquid, whereas the invention of Group IV operates using a generic measuring instrument to measure a flow characteristic of a sample liquid.

8. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention Group II operates using an electrochemical measuring instrument to measure the conductivity of a sample liquid, whereas the invention of Group V operates using a generic measuring instrument to measure a wetting property of a sample liquid.

9. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group III operates using an electrochemical measuring instrument to measure the time

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required for a sample liquid to reach an end value and the constancy of that end value, whereas the invention of Group IV operates using a generic measuring instrument to measure a flow characteristic of a sample liquid.

10. Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group III operates using an electrochemical measuring instrument to measure the time required for a sample liquid to reach an end value and the constancy of that end value, whereas the invention of Group V operates using a generic measuring instrument to measure a wetting property of a sample liquid.

11. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together, and they have different modes of operation. The invention of Group IV operates using a generic measuring instrument to measure a flow characteristic of a sample liquid, whereas the invention of Group V operates using a generic measuring instrument to measure a wetting property of a sample liquid.

12. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

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- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. Additionally, if Applicant elects Group I, Applicant will be required to elect one of the following patentably distinct species within Group I to be examined:

- A). claims 20, 23-27 and 33 where the special property of the control sample is an optical property
- B). claims 28, 34 where the special property of the control sample is a flow property
- C). claims 29, 35 where the special property of the control sample is a wetting property
- D) claims 30, 36, 38, and 39 where the special property of the control sample is the time required for the sample liquid to reach its end value
- E). claims 31, 37 where the special property of the control sample is the stability of the end value

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 19, 21-22 and 32 are generic.

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There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen M. Wallenhorst whose telephone number is 571-272-1266. The examiner can normally be reached on Monday-Thursday from 6:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Maureen M. Wallenhorst
Primary Examiner
Art Unit 1797

mmw
October 22, 2008

/Maureen M. Wallenhorst/

Primary Examiner, Art Unit 1797

Application/Control Number: 10/518,968

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